

## REMARKS

This amendment is submitted in response to the Final Official Action mailed January 20, 2006, to request reconsideration of the application in view of the remarks set forth herein. Applicant submits that the amendment is fully responsive to the outstanding Official Action for the reasons set forth below.

In the Outstanding Official Action, the Examiner rejected Claims 21-32 under 35 U.S.C. § 103(a) as being unpatentable over Applebaum, et al., United States Patent No. 6,117,126 (hereinafter "Applebaum") in view of Whitman et al., United States Patent No. 6,793,652 in further view of Tomita et al., United States Patent Pub. No. 2002/0002368 (with respect to Claim 28, the Examiner also cited Fischer, United States Patent No. 5,502,726).

Applicant respectfully disagrees with the rejections and traverses the Examiner's rejections for at least the reasons set forth below.

The claimed invention is directed to a surgery system having a plurality of medical devices combined, where each medical device has a different function. The settings are automatically changed as to whether the respective medical devices are to be joined or not in response to a connected medical device. Specifically, Claim 21 recites a control device for making **permission/non-permission determination regarding whether or not the first medical device is to be synchronized** with the second medical device in accordance with the **type of the treatment equipment** identified by the first identifying unit **when the treatment equipment connected to the first connecting portion is replaced**.

While Applebaum discloses a system for preventing devices from being operated, at the same time Applebaum's intent is to prevent a plurality of devices from being operated at the same time for safety purposes. Specifically, Applebaum suggests that it may be desirable to prevent certain instruments from operating simultaneously for safety reasons. For example, the user can be prevented from changing the operating parameters of instruments 19 when the surgeon is using foot control assembly 15 to remotely control instruments 19. In this instance, foot control assembly 15 communicates via the network directly with the user interface and the other modules 13 to provide peer-to-peer communication. Thus, information regarding functions of the modules is communicated via the network between the modules. For example, the phacoemulsification instrument is disabled by the bipolar coagulation instrument when the latter is being used and vice-versa. In contrast, the aspiration function is needed during phacoemulsification or phacofragmentation. Accordingly, information regarding both functions is communicated via the network between the phaco module 325 and either venturi IAV module 321 or scroll IAV module 323.

However, Applebaum does not disclose a system that has a plurality of medical devices operating in a combination as claimed. Specifically, Applebaum does not teach having one device joined in compliance with the driving of another device (in combination). Furthermore, Applebaum focuses on permission/nonpermission when the equipment is **used rather than first connected**. See Col. 18.

Whitman does not cure the above-identified deficiency. Whitman only discloses controlling or changing the settings of a medical device when **a single device** is connected and **is not directed to multiple devices connected to the surgery system and**

**accounting for the relationship between the devices.** Whitman teaches a control system that is configured to detect the type of surgical instrument attached to the device and to select or read the operating program or algorithm corresponding to the attached single surgical instrument. The control system or controller 122 is provided in a housing of the remote power console and is configured to control all of the functions and operations of the electro-mechanical surgical device and any surgical instrument or attachment. Further, the controller 122 is configured to read the ID data from a memory unit of the surgical instrument or attachment when the surgical instrument is initially connected or attached.

Additionally, it appears that the medical devices that are replaced or connected in Whitman are directed to one particular category of devices. In contrast, the claimed invention can allow for a plurality of different types of medical devices, having completely different functions, to be connected at the same time. The claimed device identifies the type of devices connected and adjusts the settings based upon the devices.

Tomita does not cure the above-identified deficiencies with respect to Whitman and Applebaum.

Accordingly, Applicant submits that none of the references, whether taken alone or in any combination thereof, teach, suggest or render obvious, each and every limitation of Claim 21.

With respect to Claim 22, Applicant submits that the claim is patentably distinct from the cited combination based at least upon the above-identified analysis and at least the following additional analysis. The claim recites “a second control unit provided in the second medical device, the second control unit making permission/non-permission

determination regarding whether or not the second medical device is to be synchronized with the first medical device based on the information sent from the first control unit.” (Similarly recited in Claims 25-26.) In other words, the first control unit sends information to the second control unit and the second control unit operates the medical equipment based upon this information. In the claimed invention, the first device does not “disable” the second device in the same manner vaguely described by Applebaum.

Further, the hypothetically combined references fail to teach that the first control unit sends "information regarding the type of treatment equipment" to the second medical device. In contrast, Applebaum only states that information regarding the **functions** is communicated. The claim clearly recites that the second control unit making permission/non-permission determination regarding whether or not the second medical device is to be synchronized with the first medical device **based on the information sent from the first control unit**. The feature is not taught by any of the cited references.

Accordingly, Claim 22 (and similarly Claims 25 and 26) is patentably distinct from the cited combination as the references, whether taken alone or in any combination thereof, fail to teach, suggest or render obvious, each and every limitation of the claim.

With respect to Claim 28, Applicant submits that the hypothetically combined references fail to teach that the first control unit sends the information to the second medical device at constant intervals, and that the second control unit stops the driving of the second medical device if the information from the first control unit is not received within a stipulated time period, as recited in the claim. None of the cited references suggest sending information at constant intervals. Applebaum only suggests sending information when needed.

Applicant submits that the Examiner has not established a *prima facie* case for obviousness. The Examiner has not provided a proper motivation to combine the references, which is dispositive of an obviousness case. To establish obviousness, the Examiner must make a showing of a suggestion or motivation in the art to combine the references. In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002) (Citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The motivation can come from the nature of the problem, the reference, or common knowledge. Id. The Federal Circuit stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of

ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine [modify] requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 U.S.P.Q.2d 1457-58 (Fed. Cir.1998) (citations omitted, emphasis added). Obviousness cannot be based upon what a person of ordinary skill in the art could or might try, but rather upon what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618 195 U.S.P.Q. 6 (CCPA, 1977).

Since there is no teaching of sending information at constant intervals, there is no motivation to combine Fischer with the other references. While Fischer teaches a watchdog timer, there is no suggestion or teaching in Fischer or any reference to include the watchdog timer in a surgery system analogous to the claimed invention.

Therefore, Claim 28 is patentably distinct from the hypothetically combined references.

Claims 23, 24, 27, 29-32 are patentably distinct from the cited references based at least upon their dependency, whether directly or indirectly, from Claim 21 for the reasons set forth above.

Based upon the foregoing, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 21-32 pursuant to 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Seth Weinfeld", written over the printed name.

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